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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,934	01/21/2004	Ben Wei Chen	3035P	5756
7590 03/15/2006				
SAWYER LAW GROUP LLP P.O. Box 51418 Palo Alto, CA 94303			EXAMINER MYERS, PAUL R	
			ART UNIT 2112	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/762,934

**Applicant(s)**

CHEN, BEN WEI

**Examiner**

Paul R. Myers

**Art Unit**

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 and 3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3 of copending Application No. 10/875,048. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 2, 4-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4-27 of copending Application No. 10/875,048. Although the conflicting claims are not identical, they are not patentably distinct from each other because the LED and LCD displays are claimed earlier in the current application thus changing dependency in the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/002,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the 10/002,652 claims the server is on a board instead of a USB device and the control program is specifically a BIOS. BIOS is just one of many types of control programs and it makes no difference in the functionality of the server configuring as to what the server control programs are on.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamper PN 6,654,797 in view of Ban et al PN 6,148,354.

In regards to claim 1: Kamper teaches a system for providing a server on a computing device (118), the computing device including at least a processor (202 or 204) and an optional mass storage device (232), the system comprising: bus interface logic (234) for interfacing between the computing device (118) and the system (120/320), the bus interface logic allowing the computing device to detect the system; and a memory (local storage) for storing a server image (server configuration file) for the server, booting up the server and preparing the computing device for use as the server (figure 4), the server image being provided to the computing device (405). Kamper teaches the system being a card reader and smart card. Kamper does not teach the system being a USB device including USB control program. Ban teaches a USB flash memory device for storing programs and data including USB control functions such as a software control module. It would have been obvious to implement the system of Kamper as a USB device instead of a smart card because USB is a standard, also USB memories can store way more information than a smart card thus this would have allowed for more robust server functions.

8. Claims 1, 3-4, 10, 12, 14-15, 21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garnett PN 6,851,614 in view of Ban et al PN 6,148,354.

In regards to claims 1, 12, 23: Garnett teaches a system for providing a server on a computing device (31), the computing device including at least a processor (33) and an optional mass storage device (Column 4 line 1), the system comprising: bus interface logic (77) for

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interfacing between the computing device (31) and the system (15), the bus interface logic allowing the computing device to detect the system (Figure 3 step S3-3); and a memory (67) for storing a server image (S3-7, S3-9) for the server (31), booting up the server and preparing the computing device for use as the server (figure 3), the server image being provided to the computing device (31). Garnett teaches the system being a card reader and smart card including a control program in (65). Garnett does not teach the system being a USB device including USB control program. Ban teaches a USB flash memory device for storing programs and data including USB control functions such as a software control module. It would have been obvious to implement the system of Garnett as a USB device instead of a smart card because USB is a standard, also USB memories can store way more information than a smart card thus this would have allowed for more robust server functions.

In regards to claims 3, 14: Ban et al teaches the memory being a flash memory.

In regards to claims 4, 15: Both Ban and Garnett teach control logic.

In regards to claims 10, 21: Garnett teaches an LCD display to display status information of the system. MPEP 2144.04 V C indicates to make separable is not a patentable distinction thus having a connector to connect the LCD display is not a patentably distinction.

9. Claims 2, 5-9, 11, 13, 16-20, 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garnett PN 6,851,614 in view of Ban et al PN 6,148,354 and further in view of what is well known in the art as evidenced by Kim PN 6,665,383 and Ivan et al PN 6,832,271.

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In regards to claims 2, 5-9, 13, 16-20, 24: Garnett teaches the system having buttons (Keypad 71) and a LCD display (75) for displaying system status. Garnett however is silent on the buttons allowing the server to be turned on, shutdown gracefully, or reset to an initial known state. Official notice is taken that buttons to power up/down a computer system and reset the system to its initial state are well known including timing control to eliminate spurious signals, even buttons that remotely perform these functions as evidenced by Kim. It would have been obvious to include these control buttons in the buttons of Garnett because this would have allowed for greater system control. Official notice is also taken that LED's are common status displays including status displays for USB devices, as evidenced by Ivan et al. It would have been obvious to include LED displays because LED's are low cost and simple to use. See also MPEP 2144.04 V C.

In regards to claims 11, 22: Garnett teaches the system incorporated into a single board (15) see also MPEP 2144.04 V B.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM  
March 8, 2006

  
PAUL R. MYERS  
PRIMARY EXAMINER